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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,833	04/24/2006	Nels R. Smith	026032-5052	2281
22428 7590 08/10/2009 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER VO, HAI	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 08/10/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,833

Applicant(s)

SMITH ET AL.

Examiner

Hai Vo

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-34 is/are pending in the application.
- 4a) Of the above claim(s) 13-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CIS)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

1. The 112 claim rejections have been withdrawn in view of the present amendment.
2. The art rejections over Pokorzynski et al. (US 2002/0125734) are maintained. However, other art rejections have been overcome in view of the present amendment and response. Kornlyo does not teach a second soft region is defined by a portion of the skin in direct contact with the substrate. Dailey does not disclose a visual boundary ***between the skin and substrate***. Upon further consideration, new ground of rejection is made in view of newly discovered reference to Johnson et al. (US 2007/0029829).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined

under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 26-30 and 32-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson et al. (US 2007/0029829). Johnson discloses a component for a vehicle interior comprising: a flexible skin 222 having a flange that extends substantially entirely about the periphery of the skin; a compressible material 240 coupled to the skin; a rigid substrate 230 having grooves 234 that define an area; wherein the flange of the skin are coupled to and embedded in the grooves of the substrate 230 which provides a visual boundary defined by the groove and extends substantially entirely about the periphery of the area over which the skin is provided; wherein the compressible material is located between the skin and the substrate and is configured to provide a first soft region (figures 1, 2, 4 and 5). The boundary is filled in to provide the appearance of a seamless transition between the skin and the substrate (paragraph 31). The substrate is injection molded of a polypropylene material (paragraph 21). The skin is a vacuum formed and trimmed sheet of a thermoplastic olefin material (paragraph 23). The second soft region is defined by a portion of the skin in direct contact with the substrate (paragraph 20). The flange comprises a folded back configuration (paragraph 34). Accordingly, Johnson anticipates the claimed subject matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (US 2007/0029829) as applied to claim 1 above, and further in view of Pokorzynski et al. (US 2002/0125734). Johnson does not teach a compressible material that is closed cell foam Pokorzynski discloses a component for a vehicle interior comprising: a flexible skin 25 having a flange 30 that extends substantially entirely about the periphery of the skin; a compressible material 35 coupled to the skin; a rigid substrate 8 having grooves 42 that define an area; wherein the flange of the skin are coupled to and embedded in the grooves of the substrate 18 which provides a visual boundary defined by the groove and extends substantially entirely about the periphery of the area over which the skin is provided; wherein the compressible material is located between the skin and the substrate and is configured to provide a first soft region (figures 1 and 2). The substrate is injection molded of a polypropylene material (claim 17). The compressible material is a closed cell foam (paragraph 11). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a closed cell foam for the compressible material motivated by

the desire to provide some measure of support and a soft feel to the trim assembly.

7. Claims 26 and 28-33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pokorzynski et al (US 2002/0125734). Pokorzynski discloses a component for a vehicle interior comprising: a flexible skin 25 having a flange 30 that extends substantially entirely about the periphery of the skin; a compressible material 35 coupled to the skin; a rigid substrate 8 having grooves 42 that define an area; wherein the flange of the skin are coupled to and embedded in the grooves of the substrate 18 which provides a visual boundary defined by the groove and extends substantially entirely about the periphery of the area over which the skin is provided; wherein the compressible material is located between the skin and the substrate and is configured to provide a first soft region (figures 1 and 2). The substrate is injection molded of a polypropylene material (claim 17). The compressible material is a closed cell foam (paragraph 11). The skin is injection molded of TPO (claim 14). A portion of the skin is embedded into a slot of the substrate as shown in figure 2. This reads on the claimed second soft region. Pokorzynski does not specifically disclose the skin is vacuum formed. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the component of Pokorzynski is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials,

having structural similarity as discussed above. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Pokorzynski. Accordingly, Pokorzynski anticipates or strongly suggests the claimed subject matter.

8. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pokorzynski et al. (US 2002/0125734) as applied to claim 1 above, and further in view of Hiraiwa et al (US 2002/0017360). Pokorzynski does not specifically disclose the boundary that is filled with a synthetic material to provide the appearance of a seamless transition between the skin and the substrate. Hiraiwa, however, teaches an interior trim component having a plurality of different portions in a manner that each boundary line of different portions is

hidden in a groove of the substrate and the boundary is filled with a synthetic material (figures 9-11, paragraph 41). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fill a synthetic material in the boundary line motivated by the desire to enhance the engagement of the skin material into the groove of the substrate. Note that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

9. The art rejections over Pokorzynski have been maintained for the following reasons. Applicant contends that Pokorzynski does not teach or suggest a second soft region that is defined a portion of the skin in direct contact with the substrate. That is not true. A portion of the skin is embedded into a slot of the substrate as shown in figure 2. This reads on the claimed second soft region. Accordingly, the art rejections are sustained.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ

619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 26-30, and 32-34 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29, and 34-40 of copending Application No. 10/575,436. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the '436 application fully encompass the claimed subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claim 31 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 34-40 of copending Application No. 10/575,436 in view of Pokorzynski et al. (US 2002/0125734). Johnson does not teach a compressible material that is closed cell foam and Pokorzynski discloses a component for a vehicle interior comprising: a flexible skin 25 having a flange 30 that extends substantially entirely about the periphery of the skin; a compressible material 35 coupled to the skin; a rigid substrate 8 having grooves 42 that define an area; wherein the flange of the skin are coupled to and embedded in the grooves of the substrate 18 which provides a visual

boundary defined by the groove and extends substantially entirely about the periphery of the area over which the skin is provided; wherein the compressible material is located between the skin and the substrate and is configured to provide a first soft region (figures 1 and 2). The substrate is injection molded of a polypropylene material (claim 17). The compressible material is a closed cell foam (paragraph 11). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a closed cell foam for the compressible material motivated by the desire to provide some measure of support and a soft feel to the trim assembly.

This is a provisional obviousness-type double patenting rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571) 272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hai Vo/
Primary Examiner, Art Unit 1794

